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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,906	06/07/2007	Bernd Jung	0070681-000034	2365

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1765

NOTIFICATION DATE	DELIVERY MODE
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12/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/560,906	Applicant(s) JUNG ET AL.	
	Examiner MARC S. ZIMMER	Art Unit 1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozai et al., U.S. Patent Application Publication No. 2003/0220448 in view of Okami, U.S. Patent # 5,206,104.

The Examiner decided that it would be appropriate to address the likely structure of the monoalkenylated polysiloxane component disclosed by Ozai as the rationale provided earlier as to why one of ordinary skill would select a linear compound (one devoid of T units) had been deemed to be too weak.

Like Ozai, Okami discloses an addition-curable polyorganosiloxane composition containing as one of its essential ingredients a polysiloxane compound bearing a single alkenyl group. It is said of this material in column 3, lines 38-44 that it is added to lower the modulus, or stiffness, of the cured product which is approximately the same role ascribed to this material in Ozai. Earlier in column 3, it is stated that this component is generally linear and, indeed, one of the preferred embodiments is one that, like this component of the instant invention has its alkenyl group pendant to an interior siloxane unit along the polymer backbone. It would have been obvious to the skilled artisan to use any one of the four polysiloxane compounds exhibited in column 3 as the monoalkenylated polysiloxane in Ozai.

Response to Arguments

At the outset, it is noted that Applicant has, in response to the Examiner's observation that it is virtually impossible to discern an unexpected property associated with any one element of the claimed invention, pointed out that the instant Specification mentions a commercially available product as being used in the comparative example and then proceeds to delineate what are the materials included in said commercial formulation. However, there is no indication of how they came into possession of this information and no product data sheet is enclosed to verify the accuracy of their description. In the Examiner's estimation, in the absence of the submission of product literature that confirms the stated makeup of this product, it would have been necessary and appropriate for Applicant to provide a signed Declaration containing this information. Moreover, the Examiner still believes that the systems under investigation are not described in sufficiently complete terms as to rule out another difference as being responsible for the documented effect. For example, it is not evident that both systems have the same vinyl:SiH ratio, degree of polymerization/molecular weight between crosslinks in component (B), etc. On the other hand, IF Applicant were able to show that the two systems are identical except for the presence/absence of component (C), the Examiner may in fact have a foundation on which to withdraw the rejection. This is because the presence of (C) purportedly increases elastic modulus in the present invention. By contrast, both references cited herein appear to describe an opposite effect imparted by this same material.

A recurring theme throughout Applicants' remarks is that the Ozai disclosure is too broad in its descriptions of the various components and, thus, the implication is that arriving at Applicants' invention would involve too much "picking and choosing". Respectfully, the Examiner does not regard the broad description of the prior art invention to be substantially more expansive than the claims themselves and, when one looks more closely at the favored permutations of the compounds that are correlated with claimed components (A), (B), and (C), it is clear that in total there are many fewer choices necessary to arrive at Applicants' invention. For instance, Applicant opines that the number of compounds from which the compound corresponding to component (C) is "vast" and there is nothing directing the skilled artisan to choose from this genus of compounds (described as organopolysiloxanes containing only one alkenyl group) those that adhere to the description of claimed component (C). However, as the Examiner sees it, one of the two limitations of claimed component (C), the presence of only a single alkenyl group, is anticipated and the only "picking and choosing" here would be between those that contain 2 mole % or fewer T units and those that do not. Likewise, concerning the organohydrogensiloxane component, all but perhaps a couple of the favored permutations of this compound outlined in [0021] are linear as is required by the claim and, of these, nearly half contain hydrosilyl end groups.

As for the claimed alkenyl-functional siloxane polymer, Applicant remarks that Ozai actually teaches away from this component because they purport that variable "a" corresponds to the variables "s" and "u" from the formulae in claim 10 and, whereas "s" and "u" are to have the value of zero or one, the value of "a" is 0.0001 to 0.2. This is an

Art Unit: 1765

apples-to-orange comparison. While it is true that all of "a", "s", and "u" indicate the number of alkenyl groups, "a" connotes the mol fraction of alkenyl groups in the entire polymer while "s" and "u" indicate the number of alkenyl groups in a single unit of the polymer.

Applicant alleges that the claimed ratio of silicon-bonded alkenyl groups to hydrosilyl groups is not satisfied but this is simply not true. See paragraph [0022] of Ozai. (The Examiner appreciates, incidentally, that this paragraph actually defines this ratio only for the alkenyl groups contributed by the compound corresponding to claimed component (B) but the Examiner contends that it is understood by the skilled artisan that this ratio is expected to be the same if there is also a contribution from a monoalkenylated polysiloxane.)

Finally, Applicant repeatedly notes that the cured product of the instant invention is identified as a rubber or gel, as opposed to an *adhesive* gel. This would appear to be a difference without a distinction. When modified by the teaching of Okami, the invention taught by Ozai satisfies all the limitations of the claims and, hence, would be expected to inherently possess adhesive properties.

This action has not been made final because the reasons for rejection have been slightly modified.

Art Unit: 1765

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 25, 2010

/Marc S. Zimmer/
Primary Examiner, Art Unit 1765